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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,669	12/23/1999	KELAN C. SILVESTER	42390.P8085	6426

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EXAMINER

VU, TRISHA U

ART UNIT

PAPER NUMBER

2189

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/470,669	Applicant(s) SILVESTER, KELAN C.	
	Examiner Trisha U. Vu	Art Unit 2181	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9, 12-14, 17-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. (5,648,762) (herein after Ichimura) in view of Kikinis et al. (5,793,957) (herein after Kikinis).

- a. As to claim 1, Ichimura discloses an electrical device (Fig. 1, notebook PC 100) comprising a housing to be docked into a computer (note Fig. 1, element 600), an interface disposed on a surface of the housing to enable communication between the device and the computer when the device is docked (note col. 2, lines 43-45), and a processor to operate as a system processor of the computer when the device is docked and to operate as a system processor of the device when the device is undocked (note Fig. 2, element 101 and col. 2, lines 58-61).

Ichimura fails to disclose that the computer is a notebook computer. Kikinis discloses a notebook computer with a docking bay for the device to be docked (note Fig. 5 and col.4, lines 10-13). At the time the invention was made, it would have been obvious to a person in the art to employ a notebook computer in replacement of a computer. One of ordinary skill in the art would have been motivated to do this because notebook computer is more portable.

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b. As to claim 12, Ichimura discloses a base computer (computer 200) comprising a docking port (note Fig. 1) to receive a computer (notebook PC 100) having a processor to operate as a system processor of the base computer when the device is docked and to operate as a system processor of the core computer when undocked (note col. 2, lines 58-61), and an interface to enable the communication between the computer and the base computer (note col. 2, lines 43-45).

Ichimura fails to disclose that the computer is a hand-held computer. Kikinis discloses a personal digital assistant module that can be docked into a base computer (note Fig. 5 and col.4, lines 10-13). It is obvious to a person in the art that hand-held is a personal digital assistant module type. One of ordinary skill in the art, at the time the invention was made, would have been motivated to employ a hand-held instead of a computer because hand-held is more portable.

c. As to claim 17, refer to claims 1 and 12 above. The method steps are inherent in the device shown in Ichimura as modified by Kikinis.

d. As to claim 13, Kikinis discloses a base computer (laptop computer) (note Fig. 5, element 172) with memory (note Fig. 6). He does not disclose that the memory having stored thereon an operating system. It is obvious to one of ordinary skill in the art, at the time the invention was made, that a laptop could operate by itself when undocked and so it must have its own operating system.

e. As to claim 21, refer to claims 1, 12, and 13 above. Examiner takes official notice that multiple operating system, by the time the invention was made, is being well known in the computer technology.

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f. As to claims 2 and 4, Ichimura discloses an input controller and an output controller to receive and output data when the device is undocked (note Fig. 2, element 116).

g. As to claims 3 and 6, Ichimura discloses a memory to store input data and to store thereon a mini operating system (note col. 3, lines 19-21 and col. 2, lines 61-64).

h. As to claim 5, Ichimura discloses a visual display coupled to the input/output controller (note col. 3, lines 3-9).

Ichimura fails to disclose that the visual display being coupled to the input/output controller is via pen-based. Official notice is taken by examiner that pen-based device is well-known in the art for using with some small electronic devices such as hand-helds, PDAs, etc...

i. As to claims 7-9, 14 and 19, Ichimura discloses a battery to provide power to the processor when the device is undocked, the battery is recharged when docked, and the computer provides power to the processor when docked (note col. 3, lines 52-57).

j. As to claim 18, Kikinis discloses synchronizing memory of the notebook computer with memory of the electronic device (note col. 12, lines 1-7).

3. Claims 10, 11, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. (5,648,762) (herein after Ichimura) and Kikinis et al. (5,793,957) (herein after Kikinis) as applied to claims 1-9 above, and further in view of Atkinson (5,884,049).

Ichimura and Kikinis disclose all the limitations of claims 10 and 11 except for a teaching that the processor is to operate at a higher frequency and a higher voltage when

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the device is docked than when undocked. Atkinson discloses that the processor is to operate at a higher frequency and a higher voltage when the device is docked (note the abstract and col. 1, lines 50-54). One ordinary skill in the art, at the time the invention was made, would have been motivated to employ a higher frequency and a higher voltage since this will improve the processor performance.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. (5,648,762) (herein after Ichimura) and Kikinis et al. (5,793,957) (herein after Kikinis) as applied to claims 1-9, 12, 14, 17-19 above, and further in view of Uehara et al. (5,754,798) (herein after Uehara).

Ichimura and Kikinis disclose all the limitations of claim 16 except for a teaching that the processor is to operate in one of a high power mode and low power mode according to user preference. Uehara discloses a teaching that the processor can operate in different power mode set by the user (note col.16, lines 34-44). One ordinary skill in the art, at the time the invention was made, would have been motivated to employ different power mode for the processor because the user can save the power in lower mode. Otherwise, if the user needs a high CPU performance, he/she can choose the higher mode.

Response to Arguments

5. Applicant's arguments filed 10-15-02 have been fully considered but they are not persuasive.

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With respect to Applicant's arguments on page 3 of the Remarks that Kikinis does not disclose a notebook computer with a docking bay for a device that includes a processor, which operates as a system processor of the notebook computer when the device is docked and operates as a system processor of the device when the device is undocked, and on page 4 of the Remarks that examiner further states that one of ordinary skill in the art would have been motivated to replace the desktop disclosed in Ichimura with a notebook computer because a note book computer is more portable. However, to do so would destroy the intended function of Ichimura: First, it is noted that Examiner did not address that the notebook computer of Kikinis includes a processor, which operates as a system processor of the notebook computer when the device is docked and operates as a system processor when the device is undocked. Instead, Examiner stated that the device of Ichimura (notebook PC 100) includes a processor, which operates as a system processor of the computer (computer 200) when the device is docked and operates as a system processor of the device when the device is undocked (note col. 2, lines 58-61). However, Ichimura does not disclose the computer 200 as being a notebook computer. Therefore, Kikinis reference is cited to show how to implement a notebook computer. And thus, Ichimura reference and Kikinis reference are combined in which the computer 200 of Ichimura is modified to be a notebook computer, wherein the intended function of Ichimura reference is staying the same. So, please note that this is just a physical modification of the computer to become a notebook computer. One of ordinary skill in the art, at the time the invention was made would have been motivated to make a notebook computer in place of a computer in order to make it more portable. Since this is

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just a physical modification of the computer appearance, it would not destroy the intended function of Ichimura as argued by Applicant.

For the same reasons above, a handheld device can be implemented in place of the notebook PC 100 to make the device more portable. Since this is just a physical modification wherein the intended function of the PC 100 stays the same, it would not destroy Ichimura's teaching. Also, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

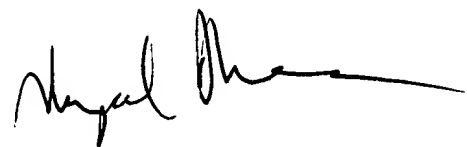
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trisha U. Vu whose telephone number is 703-305-5959. The examiner can normally be reached on Mon-Thur and alternate Fri from 7:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703-305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Trisha U. Vu
Examiner
Art Unit 2189

uv
December 16, 2002



**RUPAL DHARIA
PRIMARY EXAMINER**